

REMARKS/ARGUMENTS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments, and the following remarks. Claims 1 and 11 have been amended. No new matter has been added.

The Examiner required a restriction to one of the following two groups for further prosecution:

1. Claims 1-20, drawn to a process for preparing alkynecarboxylic acids, wherein the nitroxyl compound used as the catalyst is selected from (2,2,6,6-tetramethylpiperidine-1-oxyl) also known as TEMPO; 4-hydroxy-TEMPO, 4-OXO-TEMPO, 4-amino-TEMPO; 4-acetamido-TEMPO, 4-benzoyloxy-TEMPO and 4-acetoxy-TEMPO, and wherein the reaction medium is one or two phases;

and

2. Claims 1-20, drawn to a process for preparing alkynecarboxylic acids, wherein the limitation regarding the nitroxyl used as a catalyst and/or the number of phases used as medium of the reaction process are not defined as in group I.

Applicant elects, with traverse, the embodiment of Group 1. Applicant disagrees with the Examiner's statements that the processes in groups I and II are distinct and unrelated. The subject matter of the invention is a process using

- (i) a hypohalite as an oxidant;
- (ii) in the presence of a nitroxyl compound;
- (iii) at a pH of greater than 7
- (iv) by continuously adding the starting material (alkyne alcohol) and the hypohalite.

The restriction created by the Examiner does not lead to distinct and independent inventions for the following reasons:

(1) The number of phases in the reaction is not a relevant feature for performing the invention. The invention can be practiced in any number of phases. Typically, two phases are present or will develop but additional phases can be introduced using a supported catalyst (see p. 21, 2<sup>nd</sup> para. ". . . as an independent phase . . ." or by using a solid hypohalite as an oxidant such as calcium hypohalite (Ca(ClO)<sub>2</sub>) (cf 3<sup>rd</sup> para. on p. 21 and top of p. 26) leading to a suspension of calcium hypohalite in the one or biphasic reaction medium.

(2) Both groups proposed by the Examiner use a nitroxyl compound as a catalyst. The success of the invention does not depend on the nature of the nitroxyl compound, and limiting this compound to on the specific ones listed in the restriction requirement will unnecessarily limit the scope of protection afforded by the claims.

However, in order to simplify the search conducted by the Examiner, Applicant has amended claims 1 and 11 to specify that the nitroxyl compound corresponds to the formula (1) discussed on pp. 15-16 of the specification. This is a sufficiently narrow definition of the catalyst so as to allow for simplified searching.

It is believed that any search for the species embodied in Group I would necessarily include a search for the species embodied in Group II. Thus, a simultaneous search for all of the species is believed not to constitute an unreasonable search for the Patent Examiner. In addition, it is believed that the objectives of streamlined examination and compact prosecution would be promoted if a search were conducted simultaneously for all of the species. Also, the necessity of filing multiple patent applications for the same invention does not serve to

promote the public interest. This is because of the extra expense that is involved, in filing fees and examination costs, as well as the burden upon the public due to the necessity of searching through a multiplicity of patent files in order to find the complete range of subject matter claimed in several different patents that could otherwise be found in one issued patent only.

In the event that no generic claim is allowed, Applicant reserves the right to file divisional applications for the non-elected embodiments.

Accordingly, Applicant respectfully requests that the Examiner withdraw his restriction requirement and examine the claims as currently presented.

Respectfully submitted,  
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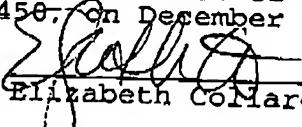
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I hereby certify that this correspondence is being sent by facsimile-transmission to the Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on December 21, 2004.

  
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